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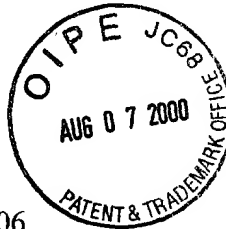
TECH CENTER 1600/2000 PATENT

Attorney Docket No. 1147-0142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#5  
B. Webb  
8-15-00

In re Reissue Application of:  
U.S. Patent No. 5,750,338



Mark L. Collins et al.

Group Art Unit: 1634

Reissue Serial No.: 09/533,906

Examiner: Unassigned

Reissue Application Filed: March 8, 2000

For: TARGET AND BACKGROUND  
CAPTURE METHODS WITH  
AMPLIFICATION FOR AFFINITY  
ASSAYS

**BOX REISSUE**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

NOTICE OF RELATED LITIGATION

Further to the submission of March 10, 2000, forwarding a Motion to Stay Proceedings,  
enclosed is the court's order denying the request for the stay.

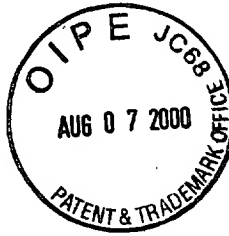
If there are any fees due in connection with the filing of this paper, please charge the fees  
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Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Jean Burke Fordis  
Jean Burke Fordis  
Reg. No. 32,984

Dated: August 7, 2000



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*Chapman*

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE, INCORPORATED,

Plaintiff,

vs.

VYSIS, INC.,

Defendant.

CASE NO. 99-CV-2668 H (AJB)

Order Denying Motion for Stay and  
for Dismissal of Fourth Cause of  
Action

On January 25, 2000, the plaintiff, Gen-Probe Incorporated ("Gen-Probe") filed a first amended complaint for declaratory relief and unfair competition relating to a patent and license agreement with the defendant Vysis, Incorporated ("Vysis"). On March 9, 2000, Vysis filed a motion to stay proceedings and for dismissal of the cause of action for unfair competition. Gen-Probe filed their opposition on April 10, 2000, and Vysis filed their reply on April 17, 2000. The motion was submitted on the papers and no oral argument was held.

BACKGROUND

Gen-Probe is a biotechnology firm which develops and continues to develop diagnostic tests called genetic probes or nucleic acid tests ("NAT"). (First Am. Compl. ¶ 6-7). Gen-probe allegedly patented a certain nucleic acid technology known as "Transcription-Mediated Amplification" which enables its products to detect "extraordinarily small quantities of the nucleic acids of infectious agents." (Id. ¶ 9). In early of 1999, Vysis informed Gen-Probe that it believed that Gen-Probe's HIV and HCV blood screening products infringed claims of their United States Patent No. 5,750,338 ("338 patent")



1 applications would guarantee its resolution within a year and the PTO's procedures concerning the  
2 examination of the application are beyond the Court's control.

3 Consequently, the Court DENIES the request for a stay at this time.

4 **II. Motion to Dismiss the Cause of Action for Unfair Competition**

5 Pursuant to Federal Rule of Civil Procedure 12(b)(6), Vysis also moves to dismiss the fourth  
6 cause of action for unfair competition under California Business and Professions Code section 17200,  
7 *et seq.* To prevail on this claim, Vysis must show that "the plaintiff can prove no set of facts in support  
8 of [its] claim that would entitle [it] to relief." See Schneider v. California Department of Corrections,  
9 151 F.3d 1194, 1996 (9th Cir. 1998). Furthermore, the Court must accept the facts that Gen-Probe  
10 asserts in its complaint as true. See Cooper v. Pickett, 137 F.3d 616, 623 (9th Cir. 1997). Section  
11 17200 proscribes unlawful, unfair or fraudulent business practices or conduct. See Cel-Tech  
12 Communications, Inc. v. Los Angeles Cellular Telephone Co., 20 Cal.4th 163, 180 (1999).

13 Gen-Probe alleges that Vysis "knows or should know the underlying facts establishing the  
14 validity of the . . . '338 patent." (First Am. Compl. ¶ 35). Gen-Probe also alleges that Vysis continues  
15 to attempt to enforce this patent despite its knowledge that the patent is invalid. (*Id.*). The Court finds  
16 that these allegations sufficiently allege a cause of action under Federal Rule of Civil Procedure  
17 12(b)(6). Consequently, the motion to dismiss is DENIED.

18 **CONCLUSION**

19 The Court DENIES the motion for a stay. The Court also DENIES the motion to dismiss the  
20 fourth cause of action.

21 **IT IS SO ORDERED.**

22 DATED: 4/28/00

23   
24 MARILYN L. HUFF, CHIEF JUDGE  
25 UNITED STATES DISTRICT COURT  
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TABLE 1		TABLE 2		TABLE 3		TABLE 4		TABLE 5		TABLE 6		TABLE 7		TABLE 8		TABLE 9		TABLE 10		TABLE 11		TABLE 12		TABLE 13		TABLE 14		TABLE 15		TABLE 16		TABLE 17		TABLE 18		TABLE 19		TABLE 20		TABLE 21		TABLE 22		TABLE 23		TABLE 24		TABLE 25		TABLE 26		TABLE 27		TABLE 28		TABLE 29		TABLE 30		TABLE 31		TABLE 32		TABLE 33		TABLE 34		TABLE 35		TABLE 36		TABLE 37		TABLE 38		TABLE 39		TABLE 40		TABLE 41		TABLE 42		TABLE 43		TABLE 44		TABLE 45		TABLE 46		TABLE 47		TABLE 48		TABLE 49		TABLE 50		TABLE 51		TABLE 52		TABLE 53		TABLE 54		TABLE 55		TABLE 56		TABLE 57		TABLE 58		TABLE 59		TABLE 60		TABLE 61		TABLE 62		TABLE 63		TABLE 64		TABLE 65		TABLE 66		TABLE 67		TABLE 68		TABLE 69		TABLE 70		TABLE 71		TABLE 72		TABLE 73		TABLE 74		TABLE 75		TABLE 76		TABLE 77		TABLE 78		TABLE 79		TABLE 80		TABLE 81		TABLE 82		TABLE 83		TABLE 84		TABLE 85		TABLE 86		TABLE 87		TABLE 88		TABLE 89		TABLE 90		TABLE 91		TABLE 92		TABLE 93		TABLE 94		TABLE 95		TABLE 96		TABLE 97		TABLE 98		TABLE 99		TABLE 100	
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